

REMARKS

Claims 1-7 and 11-21 are now pending in the application. Applicant has added, in the above amendments, claims 16-21 to more particularly claim aspects of Applicant's invention. Applicant includes a declaration and four exhibits with this response, in support of arguments below, and Applicant's representative respectfully requests that these materials be entered into the record.

In the Office Action dated February 21, 2003 ("Office Action"), the Examiner stated that the 37 CFR 1.132 Declaration filed August 5, 2002 ("1.132 Declaration") is insufficient to overcome the rejection of claims because it contains no showing that the objective evidence of nonobviousness is commensurate in scope with the claims; rejected claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over Skelton, U.S. Patent No. 4,850,611 ("Skelton") in view of Cowan, U.S. Patent No. 3,734,396 ("Cowan") and further in view of Jacobs, et al., U.S. Patent No. 4,488,737 ("Jacobs"); rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Skelton in view of Cowan and Jacobs and further in view of Zoland, U.S. Patent No. 5,303,956 ("Zoland"); and rejected claims 11-15 under 35 U.S.C. § 103(a) as being unpatentable over Skelton in view of Cowan and Jacobs and further in view of Pacione, U.S. Patent No. 6,299,401 ("Pacione I"), although, from comments by the Examiner on page 13 of the Office Action, Applicant's representative believes that the Examiner intended to employ U.S. Patent No. 5,025,978 ("Pacione II") in this rejection, and proceeds with that assumption. Applicant's representative again respectfully traverses the 35 U.S.C. § 103(a) rejections of claims 1-7 and 11-15 and respectfully disagrees with the Examiner's conclusions regarding Applicant's previously submitted 1.132 Declaration.

1.132 Declaration

Applicant's representative finds the Examiner's statements regarding the 1.132 Declaration confusing. The Examiner states that the 1.132 Declaration "refer(s) only to the system described in the above referenced application and not to the individual claims of the application. As such the declaration does not show the objective evidence of nonobviousness is commensurate in scope with the claims." The Examiner

subsequently reproduces a lengthy portion of MPEP § 716, along with paragraph 7.66.03 from which the Examiner extracted the above-quoted language. The Examiner then states:

This declaration is directed to how the invention was reduced to practice and the continued diligence of the invention and not to how the claims are nonobvious over the cited references. The submitted correspondence, purchase orders, sample forms and other materials fail to distinguish the claimed invention from the references upon which the rejections are based. The provided material dates back to the summer of 1998. The references used in the rejections were patented more than one year prior to the filing of the provisional patent application (May 20, 1999). Therefore, the examiner maintains that the declaration is insufficient to overcome the rejections of record.

These statements appear to represent a rather fundamental misreading of Applicant's declaration. First, there is not one instance of the word "system" in Applicant's declaration. In fact, Applicant has not claimed a system, but has instead claimed, in independent claims 1 and 11, a "single-sheet registration form and key packet." Moreover, this is not an overly complex invention, and certainly one that can be understood without even a technical background. Second, the 1.132 Declaration clearly and unambiguously refers to the "SINGLE-SHEET REGISTRATION FORM AND KEY PACKET, as claimed in claims 1-7 and 11-15," in 20 different places, and not once refers to a "system described in the above referenced application." Moreover, unlike in more complex technical and scientific areas, the current claim set does not include groups of claims directed to methods, groups of claims directed to systems, and groups of claims directed to computer-readable media containing program instructions. Instead, the claims are specifically directed to an easily understood, well described single-sheet registration form and key packet, and the evidence commensurate with the scope of the claims is quite simply and easily obtained by reading the current claims and then inspecting the evidence. Third, MPEP § 716 includes, following paragraph 7.66.03, the following Examiner Note: "2. A full explanation must be provided, if appropriate." Applicant's representative can find no explanation for the reference to paragraph 7.66.03 in the above-quoted statement that follows the reference. Applicant's representative believes that such an explanation is warranted, in view of the seeming inapplicability of paragraph 7.66.03 to the 1.132 Declaration.

These statements also appear to indicate a rather fundamental misunderstanding, on the part of the Examiner, of the purpose for, and legal basis of, the evidence of nonobviousness provided by Applicant. In a response filed November 27, 2002, Applicant's representative discussed the 1.132 Declaration as follows:

In Applicant's representative's opinion, Applicant's claimed invention is clearly not obvious in light of any single reference, or combination of references, so far cited by the Examiner with regard to the Prior Application. In the first Office Action Response filed by Applicant's representative, on February 12, 2001, Applicant's representative noted that:

[i]n MPEP § 2141, a standard of patentability that arose in the Supreme Court case *Graham v. John Deere*, 283 U.S. 1, 148 USPQ 459 (1966) is provided in detail. **This *Graham* standard includes secondary considerations such as commercial success, long felt but unsolved needs, failures of others, etc. While the current application is directed toward a relatively simple and straightforward invention, there are a number of such secondary considerations that would argue strongly against an obviousness-type rejection. First, the Applicant has, in the year following filing of the application, built a significant business manufacturing and selling the single-sheet registration form and key packet that is the subject of the current application. The Applicant is selling the single-sheet registration form and key packets to major hotel chains, including Hilton Hotels, which have recognized efficiencies and economies in using Applicant's invention during registration of hotel guests. No such single-sheet registration form and key packet was available prior to Applicant's entry into this field, and Applicant's clients have responded to Applicant's product enthusiastically. Second, Applicant has received notice from several print shops that the print shops have been contacted by third parties to produce single-sheet registration form and key packets as disclosed in the current application, but without the patent pending status included by Applicant on his products. While perhaps a simple invention, Applicant's invention is nevertheless important to Applicant, is extremely well regarded in the hotel industry, and is already a target for copying by Applicant's competitors.**

The Examiner has not yet responded to these noted facts, which Applicant's representative believes are strong evidence of the nonobviousness of Applicant's claimed invention. **Applicant's representative therefore has provided, in the Current Response, a signed Affidavit, accompanied by four Exhibits, from the Applicant stating: (1) that Applicant has achieved ever-increasing retail sales volume for single-sheet registration forms and key packets, as claimed by Applicant; (2) that Applicant's single-sheet registration forms and key packets have been copied and advertised for sale by competitors; (3) that a subsidiary of one of Applicant's customers has**

attempted to force Applicant to remove the "Patent Pending" notice from Applicant's products, to enable the subsidiary to offer Applicant's competitors a chance to bid on producing products that would infringe Applicant's claimed invention; and (4) that Applicant invented the single-sheet registration forms and key packets as a result of the convergence of careful observations of prior systems and techniques, experience in electronic forms production, the advent of commercially viable laser printers, and a significant development and experimentation effort. (emphasis added)

Applicant's representative believes that background information supplied in the 1.132 Declaration also supports a long-felt need for the single-sheet registration form and key packet. The inventor recognized problems with previously used registration forms and key packets many years prior to inventing his single-sheet registration form and key packet.

The *Graham v. John Deere* secondary considerations are not intended to show "how the claims are nonobvious over the cited references," as the Examiner seems to believe. Instead, these secondary considerations are meant to demonstrate that other indicia of nonobviousness, perhaps more objective than a subjective finding of obviousness based on a combination of references, strongly suggest that the claimed invention was in fact nonobvious, despite the subjective finding based on a theoretical or speculative combination of references. The Examiner herself stated, at the beginning of page 13 in the Office Action, that "it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning." The *Graham v. John Deere* secondary considerations are, in essence, objective evidence that may, in certain cases, show that, in fact, a given judgment of obviousness based on hindsight reconstruction does not comport with objective evidence to the contrary. For example, objective evidence that an invention found broad commercial acceptance, or that an invention was subsequently copied by others, suggests that, despite whatever speculative or theoretical judgement was made based on a combination of references, the invention truly was nonobvious; otherwise, why was the claimed invention not previously produced and commercialized, and why was the claimed invention copied once it was disclosed, rather than having been made independently by others to which it was theoretically obvious? In filing the 1.132 Declaration, Applicant has provided strong evidence of both commercial success, copying, and attempts to copy Applicant's

invention. Additional information provided in the 1.132 Declaration establishes a nexus between the claimed invention and the objective evidence of commercial success and copying. It was not Applicant's intention, nor is it the purpose of a 1.132 Declaration providing evidence for the *Graham v. John Deere* secondary considerations, to "distinguish the claimed invention from the references upon which the rejections are based."

In summary, Applicant's representative believes that: (1) there is no basis for invoking MPEP § 716, ¶ 7.66.03, in the current case; (2) that a full explanation of invoking MPEP § 716, ¶ 7.66.03 is required, in the current case, but not provided; and that (3) the Examiner has failed to comprehend the significance of the evidence for commercial success and copying included in the 1.132 Declaration. Again, Applicant's representative points out that, according to MPEP § 2141, "[o]bjective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, ... are relevant to the issue of obviousness and must be considered in every case in which they are present" (emphasis added).

The Examiner's Continued Assertion that Forms Disclosed in Cited References are
Computer-Printer Compatible

The Examiner, in the Office Action, continues to maintain that Skelton's unfolded form is rectangular and that Skelton's unfolded form could be fed through a laser printer. As Applicant's representative has argued previously, Skelton's unfolded form is clearly and unambiguously not rectangular, the dimensions are not specified, the type of paper is not specified, and many other such parameters are not provided in Skelton's disclosure. As noted in *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972), "[a]s a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." From Applicant's representative's experience, rectangular paper having even small departures in dimensions from standard paper sizes can cause laser printers to malfunction, let alone a relatively large protruding flap. Even were Skelton's unfolded foldable container actually rectangular, which it is not, there can

be no certainty that it would be able to be fed through a laser printer without frequent jamming, or at least infrequent jamming at levels unacceptable in commercial environments. But, with a flap of relatively large area protruding from the bottom of the foldable container, it is quite probable that the foldable container could not be used in laser-printer-based applications. The Examiner argues, on page 3 of the Office Action, that the rejection is based on an embodiment of the Skelton foldable container including only 3 panels. *Inspection of Figure 1 of Skelton clearly demonstrates that, as depicted, the protruding panel (43) would, in a three-panel embodiment, constitute fully 13% of the area of the three-panels, and would represent an excursion of fully 37% in the width of the rectangle formed by the three panels.* To refer to the proposed 3-panel-and-protruding-flap embodiment as "rectangular" or "substantially rectangular" is simply inconsistent with the well-established meaning of those terms and is misleading. To assume that such irregular-shaped forms could be fed through a laser printer is improper, especially without disclosed dimensions of the foldable container, and in view of the relatively large, protruding flap.

The Examiner states, in the Office Action:

Applicant argues that Skelton's unfolded form is not rectangular and could not be fed through a laser printer. The examiner disagrees. As seen in the figures, panels 24,26,28,30,32,34,36,38,and 40 are individually rectangular in shape and when the envelope is complete, the shape continues to be rectangular.

Applicant's representative includes, with the response, a copy of Skelton's Figure 1 with the three-panel embodiment proposed by the Examiner outlined in red. There are 5 vertices in this proposed embodiment, marked as v1-v5 by Applicant's representative – rectangles have only four vertices. The proposed embodiment has 6 edges, marked as e1-e6 by Applicant's representative – rectangles have only four edges. *The Examiner's proposed embodiment, in its unfolded form, is not rectangular.* Indeed, once folded, the folded form would be rectangular – but folded forms cannot generally be printed in computer printers. Even the thickness of single-sheet forms must be carefully controlled to allow for printing in a computer printer, as shown in materials provided as exhibits, and discussed in the following paragraph, but folded forms cannot be reliably oriented and printed in a computer printer. The single-sheet registration form and key packet includes die-cut slots and perforations for example, with critical tolerances for

compatibility with a printer, and folding the single-sheet registration form and key packet prior to printing would vastly compound the problems attendant with meeting these tolerances. Whether or not the Examiner's proposed embodiment is rectangular after folding is therefore quite immaterial. The Examiner's proposed embodiment is not rectangular when unfolded, and therefore is not suitable for printing in a computer printer in unfolded form. The Examiner's proposed embodiment is rectangular after folding, but a folded form is not printable in a computer printer. Whether folded or not folded, the Examiner's proposed embodiment would not be reliably printable in a computer printer.

Applicant provides, as an enclosure, a declaration and exhibits that detail interactions with a major client regarding certain of the many parameters that need to be considered for producing a single-sheet registration form and key packet that can be printed in a commercially available computer printer. As will hopefully be appreciated by the Examiner, producing such a form is not simply selecting dimensions and shape, although those considerations are quite important, but also involve many other considerations. Newly added claims 16-21 are directed to even more clearly claiming the single-sheet registration form and key packet in this regard.

35 U.S.C. § 103(a) Rejections

The current claims have been extensively discussed in six Office Actions and responses. Just as the Examiner apparently has not been convinced by Applicant's representative's many arguments, Applicant is not convinced that a rather complex combination of various folders and forms disclosed in the cited references, along with modifications of those folders and forms that can only be inspired and directed by hindsight recognition of the claimed invention, can be used as a basis for an obviousness-type rejection in the face of clear, previously cited case law, and the pointed directive in MPEP § 2141, under the heading "BASIC CONSIDERATIONS WHICH APPLY TO OBVIOUSNESS REJECTIONS," that "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."

Applicant's arguments are currently well documented in the record. To again summarize, with respect to the rejections of claims 1-7, Skelton discloses a ticket envelope that is not rectangular in its unfolded form, does not include die-cut key slots,


and that therefore, by itself, does not disclose even one of Applicant's claimed elements. Cowan discloses an also not rectangular ticket envelope that requires application of an adhesive during the manufacturing process, and that cannot be "quickly and accurately folded into a complete key packet in two or fewer steps." Jacobs discloses a combined key holder and booklet containing multiple sheets and that requires assembly operations in addition to simple folding operations, and that is manufactured from multiple sheets. No combination of these disclosures produces Applicant's claimed rectangular single-sheet registration form and key packet. *Not one of the cited references discloses or suggests a single-sheet, rectangular form, and none of the references discloses or suggests a single-sheet, rectangular form, or, for that matter, any form designed to be printed in a computer printer and then folded into a final product.*

Similar arguments apply to the rejections of claims 11-15. The newly cited reference, Pacione II, discloses a "two-piece kit for a portfolio folder," in which a "front panel of the kit is sized to become comparable to that of normal paper sizes and readily adapted to have printed material applied to at least one side thereof by use of standard sized photographic or offset printing equipment." The front panel is then assembled with a rear panel to "permit small quantities of folders to be produced with customized printing on the front panel at relatively low cost" (Pacione II). A more concise and germane example of teaching away from the current invention could not probably be found. Pacione uses a multi-piece assembly in order to produce a portfolio, because Pacione wants to be able to print material on the multi-sheet, folded folder, but cannot figure out a way to print the folder in commonly available photographic equipment. Applicant's claimed single-sheet registration form and key packet, by contrast, can be printed in a computer printer, and then quickly folded into a complete, useable key packet without any manufacturing or assembly steps. Applicant managed to design a registration form and key packet that can be instantiated from a single-sheet of paper with characteristics compatible for printing in a computer printer, rather than resort to printing a front panel and then assembling that front panel into a complete registration form and key packet.

Applicant maintains that the previously supplied arguments amply demonstrate that Applicant's claimed invention is not made obvious by any combination

of the cited references. Applicant believes that the provided evidence of copying and commercial success fully support the fact that Applicant's claimed invention is not obvious. All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,
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